

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD MARTIN TANNER, MATTHEW EDWARD LEWIS,
and NITU CHOUDHARY

Appeal 2007-1986
Application 09/766,407
Technology Center 2100

Decided: August 30, 2007

Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-11, 13-23, and 25-27. Claims 12 and 24 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing on this appeal was conducted on Aug. 8, 2007.

We AFFIRM-IN-PART.

THE INVENTION

The disclosed invention relates generally to generating a representation of a network workstation or other device and more particularly to a method and system for generating dynamic or personalized images by association of applications to a base image, wherein image association occurs through a rules-based system (Specification 1).

Independent claims 1 and 27 are illustrative:

1. A method of placing at least one image on a device and associating one or more additional images to the image based on preselected criteria, the method comprising the steps of:

obtaining hardware information from the device, wherein the hardware information includes at least one of device type, storage device size, and amount of random access memory;

applying an imaging server policy, wherein the imaging server policy comprises at least one rule that is applied to the device based on the hardware information;

identifying, based on the at least one rule, the at least one image that is to be placed on the device;

placing a representation of the at least one image of the device into a directory;

associating the one or more additional images to the at least one image;

creating at least one customized image, wherein the at least one customized image comprises the at least one image of the device and the one or more additional images; and

placing the at least one customized image on the device.

27. A method of dynamically customizing at least one image that is placed on a device, wherein the at least one image includes a plurality of files, the method comprising the steps of:

obtaining hardware information from the device, wherein the hardware information includes at least one of device type, storage device size, and amount of random access memory;

defining one or more file sets to include selected ones of the plurality of files;

applying an imaging server policy, wherein the imaging server policy comprises at least one rule that is applied to the device based on the hardware information;

identifying, based on the at least one rule, the at least one image that is to be placed on the device;

identifying, based on the at least one rule, the one or more file sets to be inserted in the at least one image;

placing a representation of the at least one image of the device into a directory; and

placing the at least one image on the device.

THE REFERENCE

Traversat US 6,052,720 Apr. 18, 2000

THE REJECTION

Claims 1-11, 13-23, and 25-27 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Traversat.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs, the Final Action, and the Answer for the respective details thereof.

Independent claims 1 and 13

We consider first the Examiner's rejection of claims 1 and 13 as being anticipated by Traversat. Since Appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will select independent claim 1 as the representative claim because we find it is the broadest independent claim in this group. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Appellants argue that Traversat does not disclose the following limitations of claim 1:

creating at least one customized image, wherein the at least one customized image comprises the at least one image of the device and the one or more additional images; and

placing the at least one customized image on the device.

(Claim 1; *see also* Br. 11).

Specifically, Appellants contend the Examiner has not provided adequate support to establish that Traversat's configuration information is the same as the claimed image (Br. 11).

Appellants further contend that even if configuration information for the particular client computer could be considered as an image of the device, Traversat still fails to disclose “wherein the at least one customized image comprises the at least one image of the device and the one or more additional images,” as claimed (Claim 1). Instead, Appellants argue that Traversat discloses *overriding* configuration information for the particular client computer instead of *augmenting* configuration information (Br. 11-12).

The Examiner disagrees. The Examiner reads the claimed “image” on the configuration information disclosed by Traversat (Answer 12). The Examiner restates the reasoning set forth in the Final Action, as follows:

In general, Traversat discloses a method for configuring a plurality of client computers from a single, remote server computer (see column 2, lines 49-55). Such a method allows a system administrator to efficiently propagate application changes, upgrades, and new applications to the plurality of client computers (see column 6, lines 19-31). Regarding the claimed invention, Traversat discloses that this server obtains and stores configuration information for each client computer (see column 6, lines 9-15). This configuration information is considered an “image” of the client computer, as it comprises information relating to the memory, storage, applications, and other features representing the overall configuration state of the client computer (for example, see column 8, line 60 - column 9, line 10).

(Final Action 3).

Regarding the issue of Traversat *overriding* configuration information, the Examiner contends that not every value in Traversat’s

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platform category (i.e. the at least one image) is overridden by the values of the other categories (i.e. the “one or more additional images”). The Examiner finds that only values in the platform category that have matching properties with one of the other categories are overridden. The Examiner specifically points to Traversat at col. 12, line 64 through col. 13, line 3:

At the bottom of the hierarchy in the described embodiment is the client platform entry shown at block 823. Values of properties in this entry are overridden by values of any matching properties in any of the other three categories. In other preferred embodiments, the priority order can be arranged differently and may also include additional or fewer entries in the hierarchy.

(Traversat, col. 12, l. 64 through col. 13, l. 3).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005) (citation omitted). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

Claim Construction

We begin our analysis by broadly but reasonably construing the recited term “image” in a manner fully consistent with Appellants’ Specification. We note that our reviewing court has determined that “the specification is ‘the single best guide to the meaning of a disputed term,’ and that the specification ‘acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321, 75 USPQ2d 1321, 1332 (Fed. Cir. 2005) (en banc) (internal citation omitted).

Here, when we look to the Specification for *context*, we find support for the recited term “image” on page 1:

Network tools have included the ability to “image” a workstation or other device, that is, detecting and recording information related to memory, storage, processor, applications, directory access privileges and other features and resources *representing the overall configuration state of a network device*. Generally, applications have been installed or *configured* separately on individual workstations. Thus, a great amount of time and effort may be involved on application and other updates and *configuration* [emphasis added].

(Specification 1, ll. 14-19).

Thus, when we properly construe the language of the claim by applying the broadest reasonable interpretation consistent with Appellants’ Specification, we find Traversat’s configuration data represents the overall *configuration state* of a network device (e.g., a client). Because Appellants’ Specification discloses that an “image” *represents the overall configuration state of a network device*, we agree with the Examiner that the scope of the

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claimed “image” clearly *reads on* Traversat’s storage of configuration data (*See* e.g., Traversat, col. 6, ll. 9-27).

However, Appellants have further argued that Traversat fails to disclose “wherein the at least one customized image comprises the at least one image of the device and the one or more *additional* images,” as claimed (Claim 1, emphasis added). Instead, Appellants contend that Traversat discloses *overriding* configuration information for the particular client computer instead of *augmenting* configuration information (*See* Br. 11-12).

We note the Examiner has found that only values in the platform category possessing matching properties with one of the other categories are overridden (*See* Answer 13-16). Indeed, Traversat discloses: “[v]alues of properties in this entry are overridden by values of any matching properties in any of the other three categories” (Traversat, col. 12, ll. 66-67). However, after carefully considering the evidence before us, we find that overriding (i.e., overwriting) *only* the values with *matching properties* merely *replaces* existing values with other values. Therefore, we find the weight of evidence supports Appellants’ position that Traversat fails to disclose “wherein the at least one customized image comprises the at least one image of the device and the one or more *additional* images,” as claimed (Claim 1, emphasis added). Thus, we agree with Appellants that the Examiner has failed to meet the burden of presenting a *prima facie* case of anticipation with respect to independent claim 1. Accordingly, we reverse the Examiner’s rejection of independent claim 1 as being anticipated by Traversat.

Dependent claims 2-11 and 25

Because we have reversed the Examiner’s rejection of independent claim 1, we also reverse the Examiner’s rejection of claims 2-11 and 25 as being anticipated by Traversat, noting that these claims depend directly or indirectly upon independent claim 1.

Claims 13-23 and 26

Because independent claim 13 recites limitations essentially equivalent to independent claim 1 (in particular: “customization means for creating at least one customized image, wherein the at least one customized image comprises the at least one image of the device and the one or more *additional images*”), we will also reverse the Examiner’s rejection of independent claim 13 as being anticipated by Traversat. Because we have reversed the Examiner’s rejection of independent claim 13, we also reverse the Examiner’s rejection of claims 14-23 and 26 as being anticipated by Traversat, noting that these claims depend directly or indirectly upon independent claim 13.

Independent Claim 27

We consider next the Examiner’s rejection of independent claim 27 as being anticipated by Traversat.

Appellants note that independent claim 27 recites, *inter alia*, the claim elements of, “at least one image includes a plurality of files . . . defining one or more file sets to include selected ones of the plurality of files, and . . . identifying . . . the one or more file sets to be inserted in the at

least one image.” Appellants contend there is no evidence that Traversat teaches “defining one or more file sets . . . [and] identifying . . . one or more file sets to be inserted in the at least one image,” as claimed. Appellants further argue that the Examiner’s Final Action fails to even address the claim feature of “selected ones of the plurality of files” (claim 27, l. 6). In addition, Appellants point out that Traversat discloses coalescing configuration information wherein platform configuration data for a computer type is *overridden* by other configuration information. Thus, Appellants maintain that in Traversat no file sets are *inserted* into the configuration information; rather, configuration information is *overridden* according to a predetermined hierarchy (*See* Traversat, *e.g.*, col. 12, ll. 16-22; figs. 8a and 8b). Appellants conclude that *overriding* configuration information [as taught by Traversat] is not the same as *inserting* configuration information, as claimed (Br. 15-16).

The Examiner disagrees. The Examiner notes that Traversat discloses storing configuration information in the memory of the server computer, whereby the configuration information is organized according to a particular schema, and the leaf nodes of this schema specify the configuration information (*see* Traversat, *e.g.* col. 8, l. 36 through col. 9, l. 67). The Examiner acknowledges that Traversat does not explicitly disclose configuration information stored as sets of files. Nevertheless, the Examiner maintains that files are an intrinsic and rudimentary means for storing and accessing information from the memory of a computer. The Examiner finds the configuration information maintained by Traversat’s server schema is necessarily stored as files, accessible through the schema (Answer 25).

Regarding Appellants' contention that *overriding* configuration information is not the same as *inserting* configuration information, the Examiner disagrees. The Examiner finds the customized "image" of Traversat comprises files sets. Specifically, the Examiner finds that Traversat discloses one or more file sets including selected files, e.g., the configuration information associated within the profile category, user category, and group category (*see e.g.*, col. 8, l. 36 through col. 9, l. 67). Moreover, the Examiner finds that Traversat discloses such sets of files (i.e. representing configuration information from the profile, user, or group categories) are inserted into the at least one image (i.e. profile information from the platform category) (*see* Traversat, *e.g.*, col. 11, ll. 11-67) (Answer 25-26).

After carefully considering the evidence before us, we find the weight of the evidence supports the Examiner's position that accessing Traversat's configuration information from the server schema necessitates accessing one or more files. We find that file systems are an inherent aspect of modern computer systems, such as the "Sun SPARC workstations or IBM PCs" disclosed by Traversat (*See* col. 1, l. 38). Therefore, we find that "defining one or more files sets to include selected ones of the plurality of files" is an inherent characteristic of the computer systems expressly disclosed by Traversat (claim 27; *see also* Traversat, col. 1, l. 38).

As distinguished from the "additional images" recited in each of independent claims 1 and 13, here we find that *inserting* one or more file sets, as required by the language of independent claim 27, does not require inserting *additional* configuration information. Rather, we find the recited

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language “inserting” (one or more file sets in the image) broadly but reasonably reads on *substituting* or *replacing* one configuration file (or file set) for another. Therefore, we agree with the Examiner that overriding (i.e., overwriting) a configuration file (or file set) in a group of files (i.e., a configuration “image”) is equivalent to inserting one or more file sets into an image, as claimed (claim 27). Because we find the weight of the evidence supports the Examiner’s position, we will sustain the Examiner’s rejection of independent claim 27 as being anticipated by Traversat for essentially the same reasons argued by the Examiner in the Answer.

CONCLUSION

We have sustained the Examiner’s rejection of claim 27, but we have reversed the Examiner’s rejection of claims 1-11, 13-23, 25, and 26. Therefore, the decision of the Examiner rejecting claims 1-11, 13-23, and 25-27 is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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